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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,070	09/05/2003	David Charles Lyons	12929.1062USC1	8343
23552	7590	06/20/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			COCKS, JOSIAH C	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/656,070	LYONS ET AL.	
	Examiner	Art Unit	
	Josiah Cocks	3749	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal.

Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

## ADVISORY ACTION

### *Request for Reconsideration*

1. Continuation of item 11. - Applicant argues in the response filed June 3, 2005 that evidence of the secondary consideration of "long-felt need" presented in the Rule 132 declaration by David C. Lyons executed February 17, 2005 and filed February 21, 2005 ("2/17/05 declaration") has not been considered by the examiner.

However, all evidence presented in each of the Rule 132 declarations submitted, including the declaration executed on February 17, 2005, has been considered by examiner but fails to render the claims free from the prior art. The reasons for this conclusion are articulated below.

Applicant asserts in the response filed June 3, 2005, via attorney's arguments, that the 2/17/05 declaration presents evidence of a "long-felt but unsolved need" for a burner panel made of a compression molded material, and that such evidence is sufficient to overcome the 35 U.S.C. 103 obviousness rejection on the basis of Shimek in view of Moore. However, the examiner notes that the 2/17/05 declaration is not properly construed in the manner asserted. The 2/17/05 refers specifically to the prior art of U.S. Patent No. 5,941,237 to Shimek et al. ("Shimek") and U.S. Patent No. 6,361,725 to Sinsley ("Sinsley") (see paragraph 5 of the 2/17/05 declaration) and proceeds to discuss the advantages of these techniques of compression molding over the molding techniques identified in these two references. The 2/17/05 declaration does not refer nor address the compress molding technique identified in U.S. Patent No. 3,758,317 to Moore et al. ("Moore"), which the examiner has relied upon to show the practice of compression

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molding in the burner art. Accordingly, while the 2/17/05 declaration may be considered as evidence as to the desirability of compression molding over the molding techniques presented in Shimek and Sinsley, it is not, on its face, properly construed as submitting evidence of a “long-felt but unsolved need” for compression molding in the burner art. This is particularly evident given that the 2/17/05 declaration fails to even address the Moore reference, which discusses the practice of compression molding in forming burner components (see the prior Office action for a detailed discussion of the Moore reference).

It has been held that the arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(b)(II) (citing *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)). Accordingly, the arguments of applicant’s counsel now submitted that the 2/17/05 declaration should now be considered as evidence of the secondary consideration of long-felt need are not properly considered evidence in the record, given the above noted deficiencies of the 2/17/05 declaration in addressing this secondary consideration.

Further, even if the 2/17/05 declaration were considered to provide evidence of a long-felt but unsolved need, it has been that the submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. See MPEP § 716.01(d) (citing *In re Chupp*, 816 F.2d 643, 2, USPQ2d 1437 (Fed. Cir. 1987)). Further, although the record may establish evidence of secondary consideration which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. Id. (citing *Newell Cos. V. Kenney Mfg. Co.* 864, F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988)). The disclosure of compression molding for burner components in Moore and description of the

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molding practice as a "useful technique" (see Moore, col. 8, lines 25-69) are considered to outweigh the evidence of non-obviousness present in the record.

Accordingly, the examiner maintains the rejections of the claims as presented in the Office action mailed May 4, 2005.

### *Conclusion*

2. The reply filed June 3, 2005 fails to place the application in condition for allowance. The period for reply expires THREE (3) months from the mailing of the final rejection.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at (571) 272-4877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Any questions on access to the Private

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PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197  
(toll-free).

jcc

June 14, 2005



JOSIAH COCKS  
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ART UNIT 3749